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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

020999  
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IM22/0907

NOTE: J

EXAMINER

1753

ART UNIT

PAPER NUMBER

09/07/01

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.  
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

#### PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 2 months from the filing date of the Notice of Appeal ~~mailing date of the final rejection~~.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 8/24/01. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
  - (b) ☒ they raise the issue of new matter. (see NOTE below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

#### NOTE:

see paragraphs (1) and (2) of attachment

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see paragraph (3) of attachment
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1-15
- Claim(s) withdrawn from consideration: \_\_\_\_\_

9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
11. ☒ Other: Attachment

*Janis L. Dote*  
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PRIMARY EXAMINER  
GROUP TWO

1. The proposed new claims 16-34 raise new issues that would require further consideration and/or search, because they add limitations that were not previously present in previously filed claims 1-15. The proposed claims 16-34 introduce too many new limitations to list. Each proposed new claim requires a new limitation that was not previously present in claims 1-15. For example, previously filed claim 15 did not require that the second resin having a Mn of 7,500 or more have a Tg lower than 70° C, as now required in proposed claims 16 and 29, and claims dependent thereon. Nor did claims 13 and 14 require that the binder resin be a polyolefin having a cyclic structure as now required in proposed claims 33 and 34.

Furthermore, proposed claim 20 is an improper multiple dependent claim because a multiple dependent claim should refer to other claims in the alternative only.

2. Proposed new claims 16-34 introduce new matter. For example, see proposed claims 16, 24, 29, 33, and 34.

Proposed claims 16 and 29 recite the second resin having an Mn of more than 7,500 more broadly than originally filed claim 1 or the originally filed specification. These proposed claims limit the weight percent of the second resin to less than 50% by weight of the entire binder resin only if the second resin has an intrinsic viscosity and a Mw that meet certain minimum values.

By necessary implication, the new claims permit the second resin to be present at more than 50% by weight of the entire binder resin whenever any of the two parameters intrinsic viscosity and Mw is less than the corresponding threshold value. Originally filed claim 1 and the originally filed specification require the second resin comprise less than 50 % by weight of the entire binder resin and that the intrinsic viscosity, Mn, and Mw have certain minimum values. There is no original disclosure of the broader conditions on the second resin recited in claims 16-32.

Claims 16 and 29 further recite that the second resin having a Mn of 7,500 or more, also has a Tg lower than 70°C. Contrary to applicants' comments in the Amendment filed after final rejection filed Aug. 24, 2001, Paper No. 11, page 16, lines 7-8, the originally filed specification at page 7, line 12, discloses that it is the first resin having a Mn of 7,500 or less that has a Tg of "preferably lower than 70°C." Furthermore, the particular polyolefins having a cyclic structure in sample nos. 2 and 9 of the instant specification do not provide an adequate written description of the broader second resin having a Mn of 7,500 or more recited in claims 16 and 29. Sample nos. 2 and 9 exemplify particular polyolefin resins having a cyclic structure, which have particular Mw's, intrinsic viscosities, and HDT. The broader generic second resin having a Mn of 7,500 or more recited

in claims 16 and 29 encompasses polyolefins outside the scope of sample nos. 2 and 9.

Proposed claim 24 recites that the polar wax is a charge imparting agent. The originally filed specification at page 14, lines 1-4 discloses that the polar wax is a "function imparting agent" that enhances the offset preventing effect. Thus, proposed claim 24 contains new matter.

Proposed claims 33 and 34 recite that the binder resin comprises a polyolefin resin having a cyclic structure. The originally filed specification and originally filed claim 1 only disclose a polyolefin resin having a cyclic structure comprising a first resin having a Mn of 7,500 or less, and a second resin having a Mn of 7,500 or more, a Mw of 15,000 or more, and an intrinsic viscosity of 0.25 dl/g or more, where the second resin is present in an amount of less than 50% by weight based on the entire binder resin. There is no disclosure of the broader generic polyolefin recited in claims 33 and 34.

3. Because applicants' amendment has not been entered, applicants' arguments with respect to the amendment are moot. The objections to the specification, the objection to claims 1, 7, and 9, and the rejections of claims 1-15 stand for the reasons set forth in the Final rejection mailed Feb. 21, 2001, Paper

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No. 9. In addition, applicants did not propose to amend the specification to remove the term "cyano."